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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application of:

RICHARD P. METTKE

Serial No.: 09/134,831

Filed: August 17, 1998

Title: ON-LINE COMMUNICATION  
TERMINAL/APPARATUS

2743

#9

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ATTENTION:  
Gerald Goldberg  
Art Unit: 2700

**PROTEST UNDER 37 C.F.R. § 1.291(a)**

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Hon. Commissioner of Patents  
and Trademarks  
United States Patent and Trademark Office  
Washington, D.C. 20231

Sir:

**PROTEST UNDER 37 C.F.R. § 1.291(a)**

This Protest under 37 C.F.R. § 1.291(a) is filed in Reissue Application Serial Number 09/134,831 by North Communications, Inc. of Marina Del Rey, California 90292-7090, (referred to hereinafter as "Protestor").

### **SUMMARY OF GROUNDS FOR PROTEST**

Protestor, as its basis for this Protest, states that the attached Exhibits demonstrate:

1. The subject matter claimed in the reissue application was anticipated and/or rendered obvious by prior art, as demonstrated by the documents attached hereto.
2. Both the original and new claims set forth in the reissue application are prohibited by statute as containing new matter and are therefore not patentable.

### **LISTING OF PATENTS, PUBLICATIONS OR OTHER INFORMATION RELIED UPON**

A copy of each below-listed item relied upon is attached hereto as required under 37 C.F.R. § 1.291 and listed on attached PTO Form 1449.

#### **Exhibit A**

U.S. Postal Service, The Government Connection kiosk system.

#### **Exhibit A, 1**

Kiplinger Washington Letter;

News item discussing U.S. Postal service plans for kiosks in Post Offices;

June 17, 1994.

#### **Exhibit A, 2**

U.S. Postal Service Bid Solicitation (DRAFT);

Form 102590-94-A-0011;

Dated July 8, 1994.

**Exhibit A, 3**

U.S. Postal Service brochure;  
  
Service to the Citizen Kiosk Report;  
  
July 1994.

**Exhibit A, 4**

Government Computer News;  
  
“USPS releases prototype specs for universal information kiosks”;  
  
Published August 8, 1994.

**Exhibit A, 5**

U.S. Postal Service Press Release;  
  
“Service to the Citizen Kiosk Pilot Program”;  
  
Published October 20, 1994.

**Exhibit A, 6**

U.S. Postal Service;  
  
“Transaction & Service Manager--Kiosk Station Design & Fabrication--Multi-  
  
media Design & Production”;  
  
Published November 7, 1994.

**Exhibit A, 7**

U.S. Postal Service;  
  
(Attachment to Exhibit A, 6);

Contacts list (part of bid solicitation above);

Published November 7, 1994.

**Exhibit A, 8**

U.S. Postal Service Bid Solicitation;

Form 102590-94-A-001;

Issue date: November 14, 1994.

**Exhibit A, 9**

Multimedia Monitor;

The Government Connection;

News item describing USPS announcement of Bid Solicitation for kiosk network;

December 1994.

**Exhibit B**

U.S. Patent No. 5,265,033 to Vajk et al.;

“ATM/POS Based Electronic Mail System”;

Filed September 23, 1991;

Issued November 23, 1993.

**Exhibit C**

News items concerning the Auto Clerk kiosk system.

**Exhibit C, 1**

Grunion Gazette newspaper;  
“Pay Legal Fines by Computer in L.B.”;  
Published February 6, 1992.

**Exhibit C, 2**

American City & County, a publication of Communication Channels, Inc.;  
“Your Honor, I Plead Guilty, Conveniently”;  
Published March 1992.

**Exhibit C, 3**

Government Technology, Volume 5, Number 3;  
“Paying Fines by Kiosk”;  
Published March 1992.

**Exhibit C, 4**

San Francisco Chronicle;  
“The Electronic Traffic Court”;  
Published January 8, 1992.

**Exhibit D**

News items concerning the Info/California kiosk system.

**Exhibit D, 1**

The Economist;

“Electronic democracy: The Pen is mighty”;

Published February 1, 1992.

**Exhibit D, 2**

Information Technology;

“Counties Urged to Join Information Network: Info/California Expands  
Statewide”;

Published May/June 1994.

**Exhibit E**

News item concerning the “That’s the Ticket” kiosk system.

**Exhibit E, 1**

Twins Magazine;

“Tickets By Touch”;

Published June 1993.

**Exhibit E, 2**

The Forum;

“Twins fans can add tickets to shopping list”;

Published May 25, 1993.

**Exhibit E, 3**

Minnesota Twins News Release;

“1994 Twins Tickets Now Available at ‘That’s The Ticket’ Kiosks”;



February 2, 1994.

**Exhibit F**

North Communications Sole-Source Procurement Information;  
Published 1994.

**Exhibit G**

Australian news items concerning the Info Brisbane kiosk system.

**Exhibit G, 1**

Southern Star;  
"Touching Move";  
Published January 26, 1994.

**Exhibit G, 2**

Westside News;  
"Ratepayers Enter the Computer Age";  
Published January 26, 1994.

**Exhibit H**

News item concerning the Info/Texas kiosk system.

**Exhibit H, 1**

Government Technology;

“Texas Kiosks At Your Service”;

Published May 1994.

**Exhibit H, 2**

The Dallas Morning News;

“Add job-hunting to shopping list at supermarket”;

Published February 16, 1994.

**Exhibit H, 3**

Midland Reporter Telegram

“Governor touts new video-employment information program”;

Published February 17, 1994.

**Exhibit I**

Paper by Rawn Shah;

“Suggestions for Information Kiosk Systems using the World Wide Web”;

Article available on the Internet at <http://www.rtd.com/people/rawn/kiosk-paper.html>;

Published April 30, 1994.

**Exhibit J**

**Exhibit J, 1**

Request for Proposals: Arizona Court Information System, RFP 94-1;

Preliminaries to the Quick Court kiosk system;

Published May 2, 1994.

**Exhibit J, 2**

Response to Arizona RFP 94-1;

“Proposal to implement a statewide multimedia kiosk network for the Arizona Court System”;

Preliminaries to the Quick Court kiosk system;

Published June 30, 1994.

**Exhibit K**

**Exhibit K, 1**

Letter from David C. Loy of Discover America to North Communications;

Dated July 15, 1994.

**Exhibit K, 2**

Discover America InfoCenter Program;

Published on or before July 15, 1994, and included with the letter of Exhibit K, 1 above.

**Exhibit L**

Cookware information statement from Cookware website;

“About our work with the US Postal Service”;

1994. Invoices from Cookware to U.S. Postal Service are attached as well.

**Exhibit M**

Los Alamos National Laboratory;  
"Kiosks: A Technological Overview";  
January 10, 1995.

**CONCISE EXPLANATION OF THE RELEVANCE OF EACH LISTED ITEM**

**Exhibit A**

U.S. Postal Service, The Government Connection kiosk system;

**Exhibit A, 1**

Kiplinger Washington Letter;  
News item discussing U.S. Postal Service plans for kiosks in Post Offices;  
June 17, 1994.

Exhibit A, 1 discusses the placement of electronic kiosks in the lobbies of Post Offices so that people without computers can send E-mail or access government data banks for job openings or other information. Payment of bills via kiosk is included.

**Exhibit A, 2**

U.S. Postal Service Bid Solicitation (DRAFT);  
Form 102590-94-A-0011;  
Dated July 8, 1994.

Exhibit A, 2 is a draft of the Bid Solicitation document no. 102590-94-A-0011. Exhibit A, 2 outlines the technical requirements for a kiosk system to be developed for the Government Connection project.

**Exhibit A, 3**

U.S. Postal Service brochure;  
Service to the Citizen Kiosk Report;  
July 1994.

Exhibit A, 3 discusses a report being developed concerning electronic dissemination of information, and specifically mentions a kiosk platform. The Postal Service is given as the governmental branch that will feature the kiosk system. A kiosk is described as having a box (enclosure), touch screen (input and display), computer engine (processor), and telecommunications devices. The kiosks connect people with a wide array of federal, state, local and tribal information and services. A form of payment such as a credit card reader is contemplated, and the brochure touts "one stop shopping." Internetwork access of other computers is also contemplated due to access to "several government agencies across legislative boundaries." Various public access locations for kiosk are listed, such as post offices, grocery stores, libraries, and shopping malls.

**Exhibit A, 4**

Government Computer News;  
"USPS releases prototype specs for universal information kiosks";  
Published August 8, 1994.

Exhibit A, 4 is a widely disseminated publication which discusses the Government Connection kiosk system, including hardware configuration, and Internet connectivity. Exhibit A, 4 discloses a:

processor,

communications subsystem including a modem and supporting a TCP/IP protocol with

FTP capabilities,

touch/display screen,

readers for debit cards and smart cards,

printer, and

software.

**Exhibit A, 5**

U.S. Postal Service Press Release;

“Service to the Citizen Kiosk Pilot Program”;

Published October 20, 1994.

Exhibit A, 5 describes a kiosk pilot program placing information kiosks in participating government agencies and in highly visible sites. Exhibit A, 5 states that the kiosk delivering these services will be networking government service information through the Internet and other value added networks. Exhibit A, 5 further states that the “public’s reaction . . . and willingness to pay for convenience” are strategic factors in evaluating future extension of the program. This suggests a pay-for-use mechanism to the public.

**Exhibit A, 6** (incorporated into Exhibit A, 8 and issued therewith)

U.S. Postal Service;

“Transaction & Service Manager--Kiosk Station Design & Fabrication--Multi-media Design & Production”;

Published November 7, 1994.

Exhibit A, 6, page 1 lists the transactions available on the Government Connection kiosk system, including:

- searching and applying for jobs,
- filling out applications for licenses and benefits,
- ordering and paying for documents and products,
- electronic benefit distribution,
- requests for specific personal information, and
- general governmental service information.

Exhibit A, 6, page 4 discloses a network connecting the kiosk stations to each other and to a transaction and service center.

Exhibit A, 6, page 15 states that a kiosk “shall be capable of conducting on-line transactions with agency ‘services’ or host computers connected via both local and wide-area networks.” Page 15 also describes the desired kiosk system as being able to communicate with a Transaction and Service Manager which will in turn be able to route communications to an “appropriate government agency or other network, such as a bank card network.”

Exhibit A, 6, pages 15 and 16 disclose a smart card and bank card capability for payment.

Exhibit A, 6, page 17 states that each kiosk be capable of communicating with agency databases “which are also connected to the kiosk system network via Internet.” This is an explicit disclosure of a means for accessing the Internet and allowing user interaction as set forth in Mettke’s new apparatus claim 6.

Exhibit A, 6, page 23, discloses a desired “Mosaic-like” development environment, to be employed for an Internet connection (Mosaic is an Internet browser).

Exhibit A, 6, page 31, Figure 1 shows a grid illustrating the connection of the kiosk system to other government agency computers and computer systems.

Exhibit A, 6, page 32 discloses on-line purchase and payment for services via a bank card.

Exhibit A, 6, page 33 discusses on-line forms and information accessible through the kiosk system.

Exhibit A, 6, pages 36-37 describes the provision of services as a result of payment by a bank card. Specific contemplated services are listed.

Exhibit A, 6, pages 40 and 41 disclose a Transaction and Service manager that can, among other things, manage charges to agencies and service providers, perform billing, and maintain many different “charge” models and the data required to support these charges.

Exhibit A, 6, page 44, discloses required communication characteristics, such as use of the TCP/IP Internet communications protocol, Internet Protocol (IP), Internet Control Message Protocol (ICMP), TELNET protocol, Simple Network Management Protocol (SNMP), Internet Simple Mail Transfer Protocol (SMTP), and File Transfer Protocol (FTP).



Exhibit A, 6, page 45 states that the Transaction and Service Manager must provide access to the kiosk information system via an Internet connection.

**Exhibit A, 7** (incorporated into Exhibit A, 8 and issued therewith)

U.S. Postal Service;

(Attachment to Exhibit A, 6);

Contacts list (part of bid solicitation);

Published November 7, 1994.

Exhibit A, 7, lists 113 named individuals, representing over 100 different companies, who were mailed the Bid Solicitation upon its initial issuance. Exhibit A, 7 demonstrates a broad publication of Exhibit A, 8 and Exhibit A, 6 into the public domain.

**Exhibit A, 8**

U.S. Postal Service Bid Solicitation;

Form 102590-94-A-001;

Issue date: November 14, 1994.

Exhibit A, 8, requests bids for a kiosk system capable of conducting customer inquiries against Postal Service databases located on host systems, which are also connected to the kiosk system network via the Internet. Exhibits A, 6 and A, 7 were attachments to Exhibit A, 8 and published therewith.

Exhibit A, 8, page 23 lists equipment and software to be manufactured for a kiosk of the kiosk system, including:

enclosure,

processor and processor support electronics,  
touch/display screen (display and keyboard),  
bank card reader,  
smart card reader,  
printer,  
communications subsystem including modem, TCP/IP protocol, appropriate interface  
(i.e., phone line, computer network line), etc.,  
keyboard,  
application/presentation software, and  
utility software.

The Mettke patent, by comparison, has identical elements, including a processor, telephone line, internal modem, display, keyboard, credit card reader, software, and a means for accessing commercial on-line services (e.g., dial out capability through the modem and the telephone line).

Exhibit A, 8, page 64 discloses a network support requirement of kiosk system access via the Internet.

The above specifications included in the bid solicitation document include all of the elements of the Mettke patent, including access to on-line services and pay-for-use charge models. They also disclose Internet access as set forth in Mettke's proposed new claim 6.

**Exhibit A, 9**

Multimedia Monitor;

The Government Connection;

News item describing U.S. Postal Service announcement of Bid Solicitation for a  
kiosk network;

December 1994.

Exhibit A, 9 describes the Bid Solicitation document issued by the U.S. Postal Service on November 7, 1994. The news item lists many of the kiosk system requirements as given in the Bid Solicitation (see Exhibit A, 8).

#### **Exhibit B**

U.S. Patent No. 5,265,033 to Vajk et al.;

“ATM/POS Based Electronic Mail System”;

Filed September 23, 1991;

Issued November 23, 1993.

Exhibit B adapts existing ATM/POS systems to permit users to send and receive electronic mail. Specifically, Exhibit B at col. 2, lines 6-15 provides an electronic mail system by which users can easily authorize, generate and send computer messages and responses.

Exhibit B, at col. 2, lines 18-23, discloses that the system used a debit card, a credit card or other machine readable personal identification card in conjunction with a PIN/password to regulate access. The system employs unique peripherals in conjunction with parts of existing communications networks and devices. The system uses existing networks of ATM and POS terminals together with the national and regional clearing house networks or transaction switches

that interconnect the various ATM and POS systems to provide wide public access to electronic mail services. The system of Vajk et al. includes a screen, keyboard, processor and associated software, printer, modem, communications means such as a telephone line or computer network, and a credit card reader as in the Mettke patent.

Exhibit B, at col. 7, lines 61-69, teaches an additional feature for individuals who themselves are not users of the system. This is the ability to capture charge information instead of the normal E-Mail system charges used for those with E-Mail service access. This charge capture capability is a necessary part of providing easy service bureau access to the electronic mail system. This is a pay-as-you-go access capability.

Exhibit B, col. 23, lines 28-36 teaches that after approval of a user to use the system, the message service control function handles all further control relationships with the appropriate institution processor and the store and forward message switch. The appropriate debit or credit to the user's account is the only further transaction required between the clearing house network processor and the user's financial institution processor.

Exhibit B, col. 32, lines 38-44, teaches that to provide the functions of the electronic mail system, an institution having a processor might place terminals in various public and private facilities such as airport or bus terminals, malls, financial institutions, retail merchants, hotels or such similar public and private locations.

### **Exhibit C**

Auto Clerk kiosk system;

**Exhibit C, 1:** Grunion Gazette newspaper, February 6, 1992;

**Exhibit C, 2:** American City & County, March 1992;

**Exhibit C, 3:** Government Technology, Volume 5, Number 3, March 1992;

**Exhibit C, 4:** San Francisco Chronicle, January 8, 1992;

Exhibit C discloses an Auto Clerk kiosk system, having kiosks connected to a central governmental data processing center for accessing information and for paying for services.

Kiosks feature a processor and associated software, touch screen, printer, credit card reader, and an on-line communications link to a central computer and to a clearing house network processor.

#### **Exhibit D**

Info/California kiosk system;

**Exhibit D, 1:** The Economist, February 1, 1992;

**Exhibit D, 2:** Information Technology, May/June 1994;

Exhibit D discloses kiosks that are connected to a state databank, and allow users to order birth certificates, renew vehicle registrations via credit card, view information, etc. Kiosks feature a processor and associated software, push-button video screen, printer, credit card reader, and an on-line communications link to a central computer and to a clearing house network processor.

#### **Exhibit E**

“That’s the Ticket” kiosk system for selling baseball tickets;

**Exhibit E, 1:** Twins Magazine, June 1993;

**Exhibit E, 2:** The Forum, May 25, 1993;

Exhibits E, 1 and E, 2 disclose a kiosk linked to “the Twin’s main ticket office.” Buyers can use a credit card to purchase baseball tickets and pay a surcharge for each ticket purchased. The user cannot gain access to seat availability information without first inserting a credit card. Kiosks feature a processor and associated software, touch screen, printer, ticket printer, credit card reader, and an on-line communications link to a central computer and to a clearing house network processor.

**Exhibit E, 3:** Minnesota Twins News Release, February 2, 1994.

Exhibit E, 3 discloses that in order to access the kiosk ticket system, users must pay a 15% service charge comparable to charges assessed through the Twins Ticket Lines.

#### **Exhibit F**

North Communications Sole-Source Procurement Information;

Published 1994.

Exhibit F discloses numerous kiosk systems accessible to the public. The kiosks commonly allow access to a computer network, and accept credit card payment for paying fines, buying tickets, registration of vehicles, etc. Exhibit F includes Multimedia Engine™, a proprietary software engine that includes host communications, network management, and built-in modules to communicate and settle financial accounts with major credit and debit card networks.

### **Exhibit G**

Info Brisbane kiosk system;

**Exhibit G, 1:** Southern Star, January 26, 1994;

**Exhibit G, 2:** ~~North~~ West News, January 26, 1994;

Exhibit G discloses a kiosk for conducting credit card and other financial transactions.

Kiosks feature a processor and associated software, touch screen, printer, credit card reader, and a communications link to a central computer and to a clearing house network processor.

### **Exhibit H**

Info/Texas kiosk system;

**Exhibit H, 1:** Government Technology, May 1994;

**Exhibit H, 2:** The Dallas Morning News, February 16, 1994;

**Exhibit H, 3:** Midland Reporter Telegram, February 17, 1994;

Exhibit H discloses a kiosk system that is similar to the Info/California system, except that the State of Texas doesn't own the kiosks, North Communications does, and Texas pays a charge to North for each transaction. This is a pay-as-you-go system. The kiosks are connected to an on-line government computer and computer network. Kiosks feature a processor and associated software, touch screen, printer, credit card reader, and a communications link to a central computer.

### **Exhibit I**

Paper by Rawn Shah;

“Suggestions for Information Kiosk Systems using the World  
Wide Web”;

Article available on the Internet at

<http://www.rtd.com/people/rawn/kiosk-paper.html>;

Dated April 30, 1994.

Exhibit I is a web article proposing information kiosks through which members of the public can access the World Wide Web. Exhibit I states that “commercial organizations may also wish to charge customers for access to specific documents or services. The concept of registered users and billing may be built into the server.” Exhibit I therefore teaches pay-as-you-go access to on-line service providers and the Internet. Shah discusses kiosk-based information systems, with a kiosk including a web browser or other operating software, a display, sound system, printer, touch-screen input, keyboard, kiosk-local information storage, and the network connection hardware (modem).

### **Exhibit J**

Quick Court kiosk system;

**Exhibit J, 1:** Request for Proposals: Arizona Court Information System, RFP 94-1, May  
2, 1994;

**Exhibit J, 2:** Response to Arizona RFP 94-1, June 30, 1994;



Exhibit J discloses a kiosk system where users can conduct and pay for legal transactions through a credit card, a debit card, or cash. Kiosks feature a processor and associated software, touch screen, printer, credit card reader, and an on-line communications link to a hub computer and clearing house network processor.

#### **Exhibit K**

Dated July 15, 1994;

**Exhibit K, 1:** Letter from David C. Loy of Discover America to North Communications;

Exhibit K, 1 discusses exchange of information between Discover America and North Communications.

**Exhibit K, 2:** Discover America InfoCenter Program (accompanied the above letter);

Exhibit K, 2 discloses touch-screen kiosks connected to the Internet via TCP/IP and IP protocols. Exhibit K, 2 discloses a kiosk that presents tourist information and advertising to users.

#### **Exhibit L**

Cookware information statement from Cookware website;

Exhibit L discusses Cookware's kiosk prototype built for the U.S. Postal Service prior to the issuance of Bid Solicitation 102590-94-A-001. Additionally, this kiosk was publicly presented at the Postal Forum and at GOVCOM in the fall of 1994, prior to the issuance of said Bid Solicitation. Exhibit L discloses that the kiosk included a touch screen monitor, a processor,

and a T1 connection to the Internet. A T1 line is a telephone line capable of high-speed digital communications, and is the communications link of choice for modem use and Internet access.

### **Exhibit M**

Los Alamos National Laboratory;

“Kiosks: A Technological Overview”;

Exhibit M is a White Paper that proposes and discusses a kiosk system for public use and information access. Exhibit M, page 3, states that Los Alamos National Laboratory designed a kiosk using technologies and software available in mid to late 1994.

Exhibit M discloses a public access kiosk which may incorporate some type of pay-as-you-go access (page 3 and page 26 section 7.1). Exhibit M has all of the elements of the Mettke apparatus, including:

enclosure	page 17
processor	page 6 section 3.1
telephone access node	page 26 section 7.1
internal modem	page 8 section 3.2.4
video display	page 7 section 3.1.1 and section 3.2.1
keyboard	page 7 section 3.1.1
credit card reader	page 12 section 5.1.2
means for accessing . . .	(in Mettke, this is merely combination of modem and phone line)

software for accessing . . . page 8 section 3.3.1 and 3.3.2

page 22 section 6.1

printer page 15 section 5.2.1

In addition, Exhibit M discloses a connection to the Internet (page 4, sections 2.3.2 and 2.3.3.2, and page 5 sections 2.3.3.4 and 2.3.3.7).

#### **APPLICATION OF CITED REFERENCES**

##### **A. Mettke's Claims Are Anticipated by the Prior Art**

###### **1. Exhibit A, 2**

Exhibit A, and more particularly Exhibit A, 2 and Exhibit A, 6 are believed to teach all of the apparatus elements and method steps claimed in the present reissue application.

The applicant's claims in reissue, which are directed to connecting to a commercial on-line service (claims 1-5) or the internet (claims 6-9), are anticipated by Exhibit A, 2 under 35 U.S.C. § 102(a). This reference discloses, inter alia, a processor, telephone access node, internal modem, video display/keyboard, credit card reader, means for accessing the Internet, software for accessing the Internet and credit card service centers, and a printer. Exhibit A, 2 also discloses numerous communications means for accessing an on-line service provider or the Internet, including: TCP/IP, ICMP, TELNET, SMTP, and FTP communications protocols.

<b>Mettke Apparatus Elements (Claim 1)</b> A public on-line, pay-as-you-use communications terminal comprising a housing, wherein said housing contains:	<b>Disclosed in Exhibit A, 2</b>
a central processing unit (CPU);	<u>Pages 9-10</u> : Processor.

a telephone access node;	<p><u>Page 12</u>: States that a kiosk contains “a modem capable of receiving dial-in . . . remote connections,” and that a kiosk can “dial-out/communicate.”</p> <p><u>Page 13</u>: Discloses that the internal modem have “dial-out/in access.”</p>
an internal modem coupled to the CPU and telephone access node;	<p><u>Page 12-13</u>: Discloses a 9,600 to 28.8 kbps V32/42 bis internal modem.</p>
a video display monitor coupled to the CPU;	<p><u>Page 9</u>: Discloses a display and touch-screen (a display and keyboard in one device).</p>
a keyboard for providing user interface coupled to the CPU;	<p><u>Page 7</u>: Discloses a kiosk enclosure as including a “keyboard (if present).”</p> <p><u>Page 9</u>: See above entry.</p>
a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;	<p><u>Page 16</u>: Smart card access, including reader.</p> <p><u>Page 17</u>: Bank card access, including reader.</p> <p><u>Page 27</u>: Discloses accumulation of statistics including “credit card used” and “card number.”</p>
means for accessing commercial on-line service and allow for user interaction;	<p><u>Page 12-13</u>: Includes a modem and telephone access.</p> <p><u>Page 14</u>: Network access, using TCP/IP or FTP (Transmission Control Protocol/Internet Protocol, and File Transfer Protocol).</p> <p><u>Page 14</u>: “Remote host systems shall be able to connect to the kiosk using TCP/IP.”</p>

software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers;	<p><u>Page 15</u>: Each kiosk shall be capable of conducting on-line transactions with host computers connected via both local and wide-area networks. These transactional capabilities shall be embedded within the multi-media user applications in such a fashion as to allow users a seamless ability to transact business with other computer systems without the necessity of leaving or suspending the original user interface.</p> <p><u>Page 37</u>: Discloses that service requests requiring payment in the form of a bank card "shall be transmitted to the applicable service provider."</p> <p><u>Page 43</u>: Discloses a Transaction and Service Manager software that provides the necessary data conversion function between the kiosk stations and the connected agency or service provider.</p> <p><u>Page 44</u>: Discloses that the Transaction and Service Manager maintain many different "charge" models and the data required to support such charges.</p> <p><u>Page 44</u>: Discloses that the Transaction and Service Manager software provides access to banking networks and to the Internet.</p> <p><u>Page 47</u>: Discloses that kiosks shall include telecommunications protocols including TCP/IP, ICMP, TELNET, and SNMP protocols.</p>
a printer coupled to the CPU.	<p><u>Page 17</u>: Discloses an industrial grade printer.</p>

As can be appreciated from the above table, Exhibit A, 2 includes all of the elements of the Mettke patent claim 1, including a CPU, telephone access, internal modem, display, keyboard, credit card reader, means for accessing a commercial on-line service, software to allow interface with a commercial on-line service, and a printer. Exhibit A, 2 therefore anticipates the

Mettke patent under 35 U.S.C. § 102(a). Due to the use of a modem and the statements “a modem capable of receiving dial-in” and “dial-out/in access” it is understood that the USPS kiosks require a telephone access node to be functional. The touchscreen display would be understood by a person ordinarily skilled in the art to be a combination display screen and keyboard, where a user can touch icons or characters to input that icon or character to the processor. The USPS kiosk discloses use mainly of a bank card or smart card, but also discusses use of a credit card. The means for accessing a commercial on-line service in Mettke is fully disclosed in the USPS kiosk, where a USPS kiosk includes a modem, telephone access, network access, and various communications protocols. Likewise, the software of the kiosk allows interaction with on-line host computers. The “service provider” disclosed on page 43 of Exhibit A, 2 is an on-line service provider as claimed in claim 1 of the Mettke patent. Pay-as-you-go access is given by the presence of a credit card reader, means for accessing an on-line service provider (modem and telephone access node), the capability to use a bank card to make payment for “service requests” as disclosed on page 37 of Exhibit A, 2, and the requirement to maintain many different “charge” models along with maintaining the data required to support these charges, as described on page 44 of Exhibit A, 2. Interaction with credit card service centers is also accomplished by kiosk software. The USPS kiosk includes a laser printer which may print forms under the direction of a user of the CPU, as well as a receipt printer to provide users with a receipt for each financial transaction therein performed.

<b>Mettke Apparatus Elements (Claim 2)</b>	<b>Disclosed in Exhibit A, 2</b>
The terminal in accordance with claim 1 wherein said means for accessing includes a touch screen interface attached to the monitor and further includes a touch screen means for accepting input information from said touchscreen interface and modifying program execution accordingly.	<u>Page 9</u> : Discloses that the display subsystem shall be fully equipped with all hardware and software necessary to support an integral touch-screen and touch-screen functions. User menu selections using the touch-screen are supported by an extensive touch-screen support subroutine library. The touch-screen therefore controls all kiosk operations, including accessing the Internet and on-line service providers.

<b>Mettke Apparatus Elements (Claim 3)</b>	<b>Disclosed in Exhibit A, 2</b>
The terminal in accordance with claim 1 also including, within said housing, program means for causing said printer to print a receipt or any other document available from a commercial on-line service.	<u>Page 34</u> : Discloses printing of documents or forms accessed by a user. <u>Page 38</u> : Discloses that "the user shall be able to request a printout . . . [of] a detailed record of all that has transpired."

<b>Mettke Apparatus Elements (Claim 4)</b>	<b>Disclosed in Exhibit A, 2</b>
The terminal in accordance with claim 1 wherein said housing includes a durable enclosure for the CPU, monitor, internal modem and printer, and a secured access door for service and repair.	<u>Page 7</u> : Discloses a physical housing that encloses all working parts except for user interface devices including the video display, touch-screen, bank card reader, printer paper dispensing slot, and keyboard if present. The housing therefore encloses the CPU or processor, internal modem, and printer. Also discloses that the enclosure shall be lockable and safe against tampering, liquid, and dust intrusion. Therefore, the enclosure is durable and includes some form of lockable access, such as a door.

Dependent claims 2, 3, and 4 of the Mettke patent are also anticipated by the USPS kiosk.

A USPS kiosk as disclosed in Exhibit A, 2 includes a touchscreen display/keyboard interface that

accepts input from the touchscreen and affects program execution, a program means for causing printing of accessed receipts or documents, and a durable kiosk enclosure having an access door.

<b>Mettke Method Elements (Claim 5)</b> A method of using a public on-line, pay-as-you-use terminal to access commercial on-line services comprising the steps of:	<b>Disclosed in Exhibit A, 2</b>
swiping a credit card through a credit card swipe device;	<u>Page 33</u> : Discloses that transactions may consist of providing services which require payment with a bank card such as purchasing items electronically and filing applications and paying a filing fee. <u>Page 37</u> : Discloses an ability to search for and request services and make purchases by bank card. Additionally, page 37 discloses that "some requests may only be started by the filing of the requests and paying a filing fee." <u>Page 27</u> : Discloses accumulation of statistics including "credit card used" and "card number."
if credit is denied, disallowing interaction; if credit is approved, receiving charge approval from a credit card center for use of the terminal;	<u>Page 17</u> : Discloses that a kiosk "shall be supplied with all hardware and software necessary to accept, validate, and receive payment from bank issued . . . standard credit and debit cards. Payment for goods and services using such cards shall be fully integrated into the kiosk applications software in a manner transparent to the user."
communicating said approval to CPU executing a main program;	<u>Pages 33 and 37</u> : Implicit in use of a card (see above).



in response to input from a user who is responding to a selection of on-line services that are assessable [sic] and displayed on a monitor in communication with said CPU and, based on interaction between said user and said main program, controlling switching means with said CPU to provide communication between a telephone access node and a modem with a commercial on-line service;	<p><u>Page 43</u>: Discloses a Transaction and Service Manager that routes data between a kiosk and “appropriate agency or service provider,” and makes “appropriate protocol conversions and file transfers.”</p> <p><u>Page 46</u>: Discusses kiosk communications and Postal Service plans to integrate kiosks into an existing routed network which supports the TCP/IP protocol (Transmission Control Protocol/Internet Protocol). Therefore, kiosks are capable of accessing the Internet. <u>Page 46</u> further discusses kiosk access to the Postal Routed Network, a USPS TCP/IP based network.</p> <p><u>Page 47</u>: Discusses mandatory telecommunications support requirements, including TCP/IP, Internet Control Message Protocol (ICMP), TELNET (an Internet standard protocol for remote login), and SNMP (Simple Network Management Protocol).</p>
printing with a printer a hard copy of documents said user requires, said printer being in communication with the CPU;	<p><u>Page 34</u>: Discloses printing of documents or forms accessed by a user.</p>
deactivating said CPU from commercial on-line service user interaction on appropriate input from said user;	<p>Implicit in a connection is a corresponding disconnection.</p>
printing with said printer a billing statement.	<p><u>Pages 26-27</u>: Discloses kiosk usage logging that is capable of accumulating and reporting via a print file a type of purchase, value of purchase, credit card used, card number, and date and time of use.</p> <p><u>Page 38</u>: Discloses that “the user shall be able to request a printout . . . [of] a detailed record of all that has transpired.”</p>

As shown in the above table, Exhibit A, 2 includes all of the method steps of the Mettke patent claim 5. Exhibit A, 2 therefore anticipates claim 5 under 35 U.S.C. § 102(a). The

switching step to provide communication to a commercial on-line service provider via the modem and telephone access node is given in Exhibit A, 2 on page 43, disclosing software that can make protocol conversion and file transfers to an "agency or service provider." An on-line commercial service provider such as Prodigy or AOL is such a service provider requiring protocol conversion and file transfer operations.

<b>New Mettke Apparatus Elements(Claim 6)</b> A public on-line, pay-as-you-use communications terminal comprising a housing, wherein the housing contains:	<b>Disclosed in Exhibit A, 2</b>
a central processing unit (CPU);	<u>Pages 9-10</u> : Processor.
a telephone access node;	<u>Page 12</u> : States that a kiosk contains "a modem capable of receiving dial-in . . . remote connections," and that a kiosk can "dial-out/communicate." <u>Page 13</u> : Discloses that the internal modem have "dial-out/in access."
an internal modem coupled to the CPU and telephone access node;	<u>Page 12-13</u> : Discloses a 9,600 to 28.8 kbps V32/42 bis internal modem.
a video display monitor coupled to the CPU;	<u>Page 9</u> : Discloses a display and touch-screen (a display and keyboard in one device).
a keyboard for providing user interface coupled to the CPU;	<u>Page 7</u> : Discloses a kiosk enclosure as including a "keyboard (if present)." <u>Page 9</u> : See above entry.
a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;	<u>Page 16</u> : Smart card access, including reader. <u>Page 17</u> : Bank card access, including reader. <u>Page 27</u> : Discloses accumulation of statistics including "credit card used" and "card number."

means for accessing the Internet and allow for user interaction;	<u>Page 12-13</u> : Includes a modem and telephone access. <u>Page 14</u> : Network access, using TCP/IP or FTP (Transmission Control Protocol/Internet Protocol, and File Transfer Protocol). <u>Page 14</u> : "Remote host systems shall be able to connect to the kiosk using TCP/IP."
software installed into the CPU to allow interface with the Internet and credit card service centers; and	<u>Page 17</u> : Discloses that a kiosk "shall be supplied with all hardware and software necessary to accept, validate, and receive payment from bank issued . . . standard credit and debit cards. Payment for goods and services using such cards shall be fully integrated into the kiosk applications software in a manner transparent to the user." <u>Page 43</u> : Discloses that the kiosks shall communicate to their network connection utilizing the TCP/IP protocol suite. <u>Page 44</u> : Discloses that the Transaction and Service Manager software provides access to the Internet. <u>Page 47</u> : Discloses that kiosks shall include telecommunications protocols including TCP/IP, ICMP, TELNET, and SNMP protocols.
a printer coupled to the CPU.	<u>Page 17</u> : Discloses an industrial grade printer.

Reissue claim 6 of the Mettke patent is identical to the original apparatus claim 1 except that reissue claim 6 discloses connection to the Internet instead of connection to an on-line service provider. Exhibit A, 2 clearly reads on reissue claim 6 by disclosing that the Transaction and Service Manager provides access to the Internet and by disclosing Internet communications protocols.

New Mettke Apparatus Elements(Claim 7)	Disclosed in Exhibit A, 2
The terminal of claim 6, wherein the means for accessing includes a touch-screen interface attached to the monitor and further includes a touch-screen means for accepting input information from the touch-screen interface and modifying program execution accordingly.	<u>Page 9</u> : Discloses that the display subsystem shall be fully equipped with all hardware and software necessary to support an integral touch-screen and touch-screen functions. User menu selections using the touch-screen are supported by an extensive touch-screen support subroutine library. The touch-screen therefore controls all kiosk operations, including accessing the Internet and on-line service providers.

New Mettke Apparatus Elements(Claim 8)	Disclosed in Exhibit A, 2
The terminal of claim 6, further comprising, within the housing, program means for causing the printer to print a receipt or any other document available from the Internet.	<u>Page 34</u> : Discloses printing of documents or forms accessed by a user. <u>Page 38</u> : Discloses that "the user shall be able to request a printout . . . [of] a detailed record of all that has transpired."

New Mettke Apparatus Elements(Claim 9)	Disclosed in Exhibit A, 2
The terminal of claim 6, wherein the housing includes a durable enclosure for the CPU, monitor, internal modem and printer, and a secured access door for service and repair.	<u>Page 7</u> : Discloses a physical housing that encloses all working parts except for user interface devices including the video display, touch-screen, bank card reader, printer paper dispensing slot, and keyboard if present. The housing therefore encloses the CPU or processor, internal modem, and printer. Also discloses that the enclosure shall be lockable and safe against tampering, liquid, and dust intrusion. Therefore, the enclosure is durable and includes some form of lockable access, such as a door.

As set forth in the above tables, the dependent reissue claims 7-9 disclose elements identical to that in original Mettke claims 2-4 except for Internet access, and are anticipated by Exhibit A, 2 for the same reasons as given above with regard to original claims 2-4.

**2. Exhibit A, 6**

Exhibit A, 6 is functionally identical to Exhibit A, 2, and discloses the same apparatus elements and method steps, and therefore anticipates claims 1-9 of the Mettke patent for the same reasons as given above. For example, this reference discloses, inter alia, a processor, telephone access node, internal modem, video display/keyboard, credit card reader, means for accessing the Internet, software for accessing the Internet and credit card service centers, and a printer. Exhibit A, 6 also discloses numerous communications means for accessing an on-line service provider or the Internet, including: TCP/IP, ICMP, TELNET, SMTP, and FTP communications protocols.

Therefore, Protestor believes that Exhibit A, 2 and Exhibit A, 6 anticipate under 35 U.S.C. § 102(a) the claimed subject matter of the present reissue application.

**3. Exhibit M**

Exhibit M also anticipates the reissue claims 1-9 of the Mettke patent. Exhibit M includes all of the elements of the Mettke reissue claims 1-9, including a CPU, telephone access, internal modem, display, keyboard, credit card reader, means for accessing the Internet and a credit card service center, software to allow interface with the Internet and a credit card service centers, and a printer. Exhibit M, therefore, anticipates claims 1-9 of the Mettke reissue application under 35 U.S.C. § 102(a).

**B. Mettke's Claims Are Obvious in View of the Prior Art**

**1. Exhibits B and K**

The Protestor believes that Exhibit B in combination with Exhibit K renders obvious under 35 U.S.C. § 103 claims 1-9 of the Mettke reissue application.

Exhibit B discloses a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing E-mail and sending and receiving E-mail, and a printer. Exhibit B also discloses a pay-as-you-go access. The only element Exhibit B is lacking is an explicit connection to the Internet.

Exhibit K discloses a kiosk having Internet access in addition to a processor, telephone access node, communications link, display, keyboard, credit card reader, and printer.

The combination of Exhibit B and Exhibit K includes the elements of a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing the Internet, software for interfacing with the Internet and credit card service centers, and a printer. The combination also includes a pay-as-you-go access capability.

The motivation to combine Exhibit B with Exhibit K exists in both. Exhibit B discusses as a basis for an ATM/POS based electronic mail a need for low cost communications as an alternative to the public telephone system. Exhibit B proposes the use of electronic messaging using excess capacity on computer networks and communications systems. Exhibit B suggests that this gives the general public more access to electronic communications such as E-mail. Because the purpose and motive of Exhibit B is to provide public access to electronic communications through publicly accessible ATM machines, a motivation exists to provide

faster communications links (including a range of communication links beyond E-mail) utilizing standard protocols of an open system architecture, such as the Internet. This purpose is a strong motive to combine Exhibit B and Exhibit K. In addition, Exhibit K suggests the use of the Internet and Internet communications protocols to provide data and information through publicly-accessible kiosks. Exhibit K also suggests another motive for combination in that the use of high-speed data communications may be employed to update data in a kiosk.

**2. Exhibits B and I**

The Protestor believes that Exhibit B in combination with Exhibit I renders obvious under 35 U.S.C. § 103 claims 1-9 of the Mettke reissue application.

Exhibit B discloses a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing E-mail and sending and receiving E-mail, and a printer. Exhibit B also discloses a pay-as-you-go access. The only element Exhibit B is lacking is an explicit connection to the Internet.

Exhibit I discloses a processor, telephone access node, modem, display, keyboard, means for accessing the Internet, software for interfacing with the Internet, and a printer. Exhibit I also includes pay-as-you-go access.

The combination of Exhibit B and Exhibit I includes the elements of a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing the Internet, software for interfacing with the Internet and credit card service centers, and a printer. The combination also includes a pay-as-you-go access capability.

The motivation to combine Exhibit B with Exhibit I exists in both. Exhibit B suggests the use of ATM machines to give the general public more access to electronic communications such as E-mail. Because the purpose and motive of Exhibit B is to provide public access to electronic communications through publicly accessible ATM machines, a motivation exists to provide faster communications links (including a range of communication links beyond E-mail) utilizing standard protocols of an open system architecture, such as the Internet. This purpose is a strong motive to combine Exhibit B and Exhibit I. In addition, Exhibit I suggests the use of Internet access for a public access kiosk system. Exhibit I teaches the use of the Internet for its user-friendly interface, popularity and widespread use, and combination of text, graphics and sound. Exhibit I therefore gives another independent motive for combining Exhibit B and Exhibit I

**3. Exhibits B and L.**

The Protestor believes that Exhibit B in combination with Exhibit L renders obvious under 35 U.S.C. § 103 both the original claims and the reissue claims of the Mettke patent.

Exhibit B discloses a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing E-mail and sending and receiving E-mail, and a printer. Exhibit B also discloses a pay-as-you-go access. The only element Exhibit B is lacking is an explicit connection to the Internet.

Exhibit L discloses a kiosk having a means for accessing the Internet and software for interfacing with the Internet.



The combination of Exhibit B and Exhibit L includes the elements of a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing the Internet, software for interfacing with the Internet and credit card service centers, and a printer. The combination also includes a pay-as-you-go access capability.

The motivation to combine Exhibit B with Exhibit L exists in both. Exhibit B suggests the use of ATM machines to give the general public more access to electronic communications such as E-mail. Because the purpose and motive of Exhibit B is to provide public access to electronic communications through publicly accessible ATM machines, a motivation exists to provide faster communications links (including a range of communication links beyond E-mail) utilizing standard protocols of an open system architecture, such as the Internet. This purpose is a strong motive to combine Exhibit B and Exhibit L. In addition, Exhibit L suggests the use of Internet access for a public access kiosk system.

**4. Exhibit I in Combination with Any of C, D, E, F, G, H, or J**

The Protestor believes that Exhibit I in combination with any one of Exhibits C, D, E, F, G, H, or J renders obvious under 35 U.S.C. § 103 claims 1-9 of the Mettke reissue application.

Exhibits C, D, E, F, G, H, and J disclose a processor, telephone access node, internal modem, display, keyboard, credit card reader, and printer. Exhibits C, D, E, F, G, H, and J lack Internet access.

Exhibit I discloses a processor, telephone access node, modem, display, keyboard, means for accessing the Internet, software for interfacing with the Internet, and a printer. Exhibit I also includes pay-as-you-go access.

The combination of Exhibit I and any one of Exhibits C, D, E, F, G, H, or J includes the elements of a processor, telephone access node, internal modem, display, keyboard, credit card reader, means for accessing the Internet, software for interfacing with the Internet and credit card service centers, and a printer. The combination also includes a pay-as-you-go access capability.

The motivation to combine Exhibit I and any one of Exhibits C, D, E, F, G, H, or J is found in Exhibit I. Exhibit I discloses the use of Internet access for a public access kiosk system. Exhibit I teaches the use of the Internet for its user-friendly interface, popularity and widespread use, and combination of text, graphics and sound. The motivation for combining Exhibit I and any one of Exhibits C, D, E, F, G, H, or J is that a kiosk could be made more universally acceptable, useful, and easier to use.

Therefore, the Protestor believes that the present reissue claims, both the original claims and the additional claims sought at reissue, are either anticipated or made obvious by the printed publications cited in this paper.

**C. Mettke's Claims Are Anticipated by the TouchFax Product**

In addition, the Protestor has reviewed and agrees with all materials submitted in protest on November 3, 1998, by Richard P. Stitt on behalf of TouchNet Information Systems, Inc.

The Protestor believes that the original Mettke patent is anticipated by the TouchNet Information Systems product TouchFax, as analyzed below with respect to Exhibits submitted in the TouchNet Protest.

<b>Mettke Apparatus Elements (Claim 1)</b> A public on-line, pay-as-you-use communications terminal comprising a housing, wherein said housing contains:	<b>Disclosed in TouchNet Protest, Exhibits D and E</b>
	<u>Exhibit E: page 48, lines 38-44</u> Discloses a pay-per-use kiosk for faxes and access to information services.
a central processing unit (CPU);	<u>Exhibit E: page 49, col. 1, line 18</u>
a telephone access node;	<u>Exhibit E: page 49, col. 1, line 20</u> Discloses a "data port."
an internal modem coupled to the CPU and telephone access node;	<u>Exhibit E: page 49, col. 1, line 20</u> Discloses a modem.
a video display monitor coupled to the CPU;	<u>Exhibit E: page 49, col. 1, lines 2-6</u> Discloses a "touch-sensitive color video monitor which provides instructions to the user and on-screen buttons to operate the terminal functions."
a keyboard for providing user interface coupled to the CPU;	<u>Exhibit E: page 49, col. 1, lines 2-6 and 19-20</u> Discloses a touch-sensitive monitor, and a full-size keyboard.
a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;	<u>Exhibit E: page 49, col. 1, lines 10-12</u> Implies a credit card reader by disclosing that "payment for services is made by using credit card or other magnetic card such as a telephone calling card."
means for accessing commercial on-line service and allow for user interaction;	<u>Exhibit E: page 49, col. 1, line 20</u> Discloses a "data port." <u>Exhibit E: page 49, col. 1, line 20</u> Discloses a modem.

software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers;	<b>Exhibit D:</b> Discloses a TouchFax Electronic Library that gives access to an "on-line interactive data base." Examples given are corporate databases such as employee benefits information, public databases such as accounts with CompuServe and Prodigy, special interest databases such as USA Today Sports Center, and BBS's (electronic bulletin boards).
a printer coupled to the CPU.	<b>Exhibit E:</b> page 49, col. 1, line 19 Discloses a "high-volume laser printer."

As can be appreciated from the above table, the TouchNet TouchFax product as described in TouchNet Protest Exhibits D and E (and additionally in TouchNet Protest Exhibits C, F, G, J, K, and L), includes all of the elements of the Mettke patent claim 1, including: a CPU, telephone access, internal modem, display, keyboard, credit card reader, means for accessing a commercial on-line service, software to allow interface with a commercial on-line service, and a printer. The TouchFax product as described in Exhibit D, dated 1991, and Exhibit E, dated October 1992, therefore anticipates claims 1-9 of the Mettke reissue application under 35 U.S.C. § 102(a) and under 35 U.S.C. § 102(b).

<b>Mettke Apparatus Elements (Claim 1)</b> A public on-line, pay-as-you-use communications terminal comprising a housing, wherein said housing contains:	<b>Disclosed in TouchNet Protest, Exhibit K, deposition of Daniel J. Toughey</b>
a central processing unit (CPU);	<b>Exhibit K:</b> page 88, lines 2-3
a telephone access node;	<b>Exhibit K:</b> page 88, line 45
an internal modem coupled to the CPU and telephone access node;	<b>Exhibit K:</b> page 88, lines 6-10
a video display monitor coupled to the CPU;	<b>Exhibit K:</b> page 88, lines 11-12
a keyboard for providing user interface coupled to the CPU;	<b>Exhibit K:</b> page 88, lines 13-15

a credit card reader swipe device coupled to the CPU for accepting payment by a user for use of the terminal;	<b>Exhibit K:</b> page 88, lines 16-24
means for accessing commercial on-line service and allow for user interaction;	<b>Exhibit K:</b> page 88, line 25 to page 89, line 2
software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers;	<b>Exhibit K:</b> page 89, lines 5-19 page 90, lines 9-18 page 96, lines 2-8
a printer coupled to the CPU.	<b>Exhibit K:</b> page 94, lines 9-11 page 96, lines 9-10

Additionally, as can be appreciated from the above table, the TouchNet TouchFax product as described in the deposition of TouchNet Protest Exhibit K includes all of the elements of the Mettke patent claim 1, including a CPU, telephone access, internal modem, display, keyboard, credit card reader, means for accessing a commercial on-line service, software to allow interface with a commercial on-line service, and a printer. The TouchFax product as described in TouchNet Protest Exhibit K (discussing the TouchFax product as shown in a videotape produced May 1993), therefore anticipates claims 1-9 of the Mettke reissue application under 35 U.S.C. § 102(a) and under 35 U.S.C. § 102(b).

<b>Mettke Apparatus Elements (Claim 2)</b>	<b>Disclosed in TouchNet Protest, Exhibit E</b>
The terminal in accordance with claim 1 wherein said means for accessing includes a touch screen interface attached to the monitor and further includes a touch screen means for accepting input information from said touchscreen interface and modifying program execution accordingly.	<b>Exhibit E:</b> page 49, col. 1, lines 2-6 Discloses a "touch-sensitive color video monitor which provides instructions to the user and on-screen buttons to operate the terminal functions."

<b>Mettke Apparatus Elements (Claim 3)</b>	<b>Disclosed in TouchNet Protest, Exhibit E</b>
The terminal in accordance with claim 1 also including, within said housing, program means for causing said printer to print a receipt or any other document available from a commercial on-line service.	<u>Exhibit E: page 49, col. 1, lines 12-15</u> Discloses that the TouchFax kiosk “provides a detailed printed receipt.” Exhibit E discloses a variety of information that may be printed out by a user.

<b>Mettke Apparatus Elements (Claim 4)</b>	<b>Disclosed in TouchNet Protest, Exhibit G</b>
The terminal in accordance with claim 1 wherein said housing includes a durable enclosure for the CPU, monitor, internal modem and printer, and a secured access door for service and repair.	<b>Exhibit G:</b> Shows a durable enclosure housing a CPU, monitor, modem and printer. Enclosing the working components of a device located in a public area is obvious and well-known in the art, as is having a secured access door for service and repair.

Dependent claims 2, 3, and 4 of the Mettke patent are also anticipated by the TouchFax kiosk. A TouchFax kiosk as disclosed in Exhibits E and G of the TouchNet Protest include a touchscreen display/keyboard interface that accepts input from the touchscreen and affects program execution, a program means for causing printing of accessed receipts or documents, and a durable kiosk enclosure having an access door.

<b>Mettke Method Elements (Claim 5)</b> A method of using a public on-line, pay-as-you-use terminal to access commercial on-line services comprising the steps of:	<b>Disclosed in TouchNet Protest, Exhibit K, deposition of Daniel J. Toughey</b>
swiping a credit card through a credit card swipe device;	<b>Exhibit K:</b> page 93, lines 12-18
if credit is denied, disallowing interaction; if credit is approved, receiving charge approval from a credit card center for use of the terminal;	<b>Exhibit K:</b> page 93, lines 19-24

communicating said approval to CPU executing a main program;	<b>Exhibit K:</b> page 93, lines 19-24
in response to input from a user who is responding to a selection of on-line services that are assessable [sic] and displayed on a monitor in communication with said CPU and, based on interaction between said user and said main program, controlling switching means with said CPU to provide communication between a telephone access node and a modem with a commercial on-line service;	<b>Exhibit K:</b> page 93, line 25 to Page 94, line 2
printing with a printer a hard copy of documents said user requires, said printer being in communication with the CPU;	<b>Exhibit K:</b> <u>page 96, lines 9-10</u> Discloses a printer. It is obvious to allow a user to printout data the user has accessed.
deactivating said CPU from commercial on-line service user interaction on appropriate input from said user;	Deactivation is implied in activation. A device that cannot be deactivated would be impractical and unacceptable.
printing with said printer a billing statement.	<b>Exhibit K:</b> page 94, lines 9-11

The TouchNet self-service device therefore contains all of the elements of the original Mettke patent. The TouchNet self-service device was publicly promoted as capable of accessing on-line services, was indeed capable of accessing on-line services. Actual access of on-line services was achieved as early as May 1993, with access to Prodigy, as described in TouchNet Protest Exhibit L, page 8, lines 7-11.

The TouchNet self-service device was publicly promoted as capable of charging users on a pay-per-use basis, was indeed capable of charging users on a pay-as-you-use basis, and in one instance in 1993, was delivered to a TouchNet client, Bell Canada, with a fully functional ability to charge users on a pay-per-use basis for its on-line service (see Exhibit K, page 84, line 6

through page 85, line 15). Although delivered in Canada, the functionality of the self-service device was developed, tested, and made fully functional in the State of Kansas in the United States.

Furthermore, the idea of charging users on a pay-as-you-use basis for a self-service device providing communications access is at least as old as the long distance pay telephone. The idea of charging users on a pay-as-you-use basis for a self-service device was also being utilized in the early 1990's by on-line services for from-the-desktop access to certain data libraries. Charging users on a pay-as-you-use basis for a self-service device is therefore a non-novel method of charging users for access to telecommunications and/or information services.

**THE CLAIMS IN THE REISSUE NOT IN THE ORIGINAL  
PATENT ARE PROHIBITED BY STATUTE AS NEW MATTER**

New claims 6-9 added in the Mettke reissue application are unpatentable for the additional reason that they contain new matter.

35 U.S.C. § 251 states that "no new matter shall be introduced into the application for reissue." The statute also states that a patent may be reissued for "the invention disclosed in the original patent." 35 U.S.C. § 251.

New claims 6-9 are virtually identical to the claims in Mettke's patent except that they claim connection to the Internet. However, the original patent does not disclose anything about connection to the Internet.

The patent, as granted, is the basis for the specification of the reissue application. Adding claims addressing the Internet constitutes new matter which is clearly prohibited by the statute.



Although the originally filed application disclosed connection to the Internet, that subject matter was deleted from the specification and claims prior to issuance of the patent. The patent, as granted, did not mention the Internet. Accordingly, the new claims in the reissue application directed to the Internet are prohibited by statute and cannot be the subject of a reissue.

**THE ORIGINAL PATENT CLAIMS CARRIED  
FORTH IN THE REISSUE APPLICATION ARE  
PROHIBITED BY THE STATUTE AS NEW MATTER**

Claims 1-5 in the Mettke reissue application are unpatentable for the additional reason that they contain new matter. During the initial prosecution of the Mettke patent application, Mettke responded to the first Office Action by amending the specification to add new matter and by adding a completely new drawing (compare with original drawing) which also contained new matter. Mettke then amended the claims to expressly recite this additional new matter, as described below:

- First, claim 1 was amended to claim a "housing" and structure "contained" therein, reciting:

"1. A public on-line, pay-as-you-use communications terminal comprising a housing, wherein said housing contains . . ."

However, this structure related to the housing was added as new matter in both a) the drawings and b) the description in the Applicant's response after the filing date of Mettke's original patent application.

With respect to the drawings, original FIG. 2 -- the only original figure with any structure -- showed a "terminal work shelf" and "privacy cubicle." Thus, the original disclosure merely

mentioned a work shelf. No housing was disclosed. The pro se applicant then deleted FIG. 2 -- entirely! -- and replaced it with a new FIG. 2 having completely different structure -- namely, showing a housing 10 that was never before disclosed and structure therein and associated therewith never previously disclosed nor in any way inherent in the original disclosure.

With respect to the specification, the "housing" and manner of "containing" claimed in claim 1 was also added as new matter in the Amendment (see Examiner's note at B5) as follows:

A typical embodiment of the terminal is illustrated in figure 2. \* \* \* Numeral 14 generally indicates the printer paper discharge chute. Numeral 15 generally indicates the location of the printer behind the terminals access door. Numeral 16 generally indicates the location of the CPU with internal modem behind the terminals access door. Numeral 17 generally indicates the location of the access door.

- Second, claim 2 was amended to claim:

"a touch screen interface attached to the monitor and ... means for accepting input information from said touch screen interface ...."

However, this touch screen was added as new matter in the Amendment at page 3 (see Examiner entry B6) via the language:

"A representative CPU with internal modem, monitor and printer could be of the IBM AST series. A representative touch screen with controller could be of the series manufactured by Interaction Systems. A representative credit card reader could be the MAGTEK 21055002."

- Third, claim 3 was amended to claim:

"means for causing said printer to print a receipt ... from a commercial on-line service."

However, the printing of such a limitation (i.e., claimed in means-plus-function language) was never disclosed, or implied, or in any way inherent or suggested in the original disclosure. Never was the printing of a receipt indicated or implied.

- Fourth, claim 4 was amended to claim:

"wherein said housing includes a durable enclosure for the CPU, monitor, internal modem and printer, and, a secured access door for service and repair."

Once again, the "durable enclosure" and "access door" and other limitations in this claim were never disclosed nor implied nor in any way inherent or suggested in the original disclosure.

- Fifth, claim 5 was amended to claim:

- a) "executing a main program in response to input from a user who is responding to a selection of on-line services that are assessable and displayed on a monitor;" and
- b) "printing with said printer a billing statement"

Among other things, this selection display on the monitor and this printing of a billing statement was not previously disclosed.

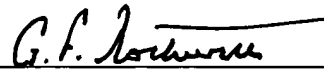
In addition to the foregoing, Mettke also rewrote his specification and claims eliminating reference to the "Internet" (which is now the very subject for which the reissue is sought).

Additional new matter was also entered (e.g., via additions and/or deletions) at a variety of other places in the rewritten specification.

**SUMMARY**

There is no basis for sustaining the original claims as such are anticipated and there is no basis or support for expanding the claims to cover the Internet as in the subject application.

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I, G. Franklin Rothwell, hereby certify a copy of the foregoing PROTEST under 37 C.F.R. § 1.291 and all exhibits identified therein were served via U.S. Mail, first class postage prepaid, this 31st day of March 1999, upon:

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